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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/864,261
Filing Date: May 25, 2001
Appellant(s): HAZUMI, MICHIHIRO

Artem N. Sokolov
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 02/05/2008 appealing from the Office action mailed 06/04/2007.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct, i.e. the after final amendment filed 08/17/2007 has not been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,823,948	ROSS ET AL	10-1998
6,564,121	WALLACE ET AL.	5-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 2, 8, 10, 14, 16, 22, 25, 26 and 30 are rejected under 35 U.S.C. 102 (b) as being anticipated by Ross et al (US Pat# 5,823,948, hereinafter Ross).

A. As per claim 2, Ross discloses an electronic medical record information management system (Ross: col 4, lns 52-53), comprising:

at least one electronic medical record information managing means;

a plurality of electronic medical record showing means;

and

a communication network that connects the at least one of said electronic medical record information managing means to said plurality of electronic medical record showing means (Ross: Fig. 1), wherein:

each of

said plurality of electronic medical record showing means, comprises:

a first communication unit for connecting to said communication network
(Ross: Fig. 1, in particular the lines connecting items 7 and 9);

and

at least one first electronic medical record terminal (Ross: Fig. 1, items 9
and 10) that

makes electronic medical records of patients and transmits said electronic medical records to said electronic medical record information managing means through said first communication unit and said communication network (Ross: col 5, lns 53 – 60),

and

makes a request of a user to transmit one or more of said electronic medical records stored in said electronic medical record information managing means, and transmits said request to said electronic medical record information managing means through said first communication unit (Ross: col 7, lns 5 – 16, Fig. 2, items 102-103),

and

shows one or more of said electronic medical records transmitted from said electronic medical record information managing means to said user (Ross: col 5, lns 56 – 60),

and

said electronic medical record information managing means, comprises:

a second communication unit for connecting to said communication network (Ross: item 8 in particular, note that it connects items 3 and 7);

an electronic medical record storer that stores said electronic medical records of said patients that were transmitted from said electronic medical record showing means (Ross: col 5, ln 66 to col 6, ln 3);

and

a control server (Ross: col 5, lns 22-24; Fig. 1, item 2, reads on Master Server) that obtains one or more of said electronic medical records stored in said electronic medical record, storer and transmits the obtained one or more of said electronic medical records to said electronic medical record showing means through said second communication unit (Ross: col 4, lns 52-59; col 6, lns 3-10),

wherein:

said at least one first electronic medical record terminal further includes means for adding information to each of said electronic medical records and transmits said electronic medical records and means for transmitting

said electronic medical records having the added information to said electronic medical record information managing means through said first communication unit,

and

said control server further makes said electronic medical record storer store said electronic medical records received from said electronic medical record showing means through said second communication unit (Ross: col 5, ln 66 to col 6, ln 3),

and

said control server judges whether said user who transmitted said request is a user who has a second access right or not, and when said user has said second access right, said control server makes said electronic medical record storer store said electronic medical records (Ross: Fig. 2, item 101; col 6, section 101 "Security Validation Module", note the variety of methods described by which personnel can demonstrate their identity. Note further the restrictions on types of information different types of personnel are allowed to store on the system, for example, physicians can write prescriptions, but clerks can only enter demographic information. In

this example, the Examiner considers that the physician has a second access right with respect to the clerk).

B. As per claims 8, Ross discloses an electronic medical record information management system in accordance with claim 2, wherein:

said control server judges whether said user who transmitted said request is a user who has a first access right or not, and when said user has said first access right, said control server obtains said electronic medical record of said patient designated by said request from said electronic medical record storing server (Ross: Fig. 2, item 101; col 6, section 101 "Security Validation Module"; col 3, lns 33 - 43).

C. As per claims 10, Ross discloses an electronic medical record information management system in accordance with claim 8, wherein: said electronic medical record showing means, further comprising:

a first access right information making unit that transmits first access right information with which said control server judges whether said user has said first access right or not to said electronic medical record information managing means through said first communication unit, wherein: said control server judges whether said user who transmitted said request is said user who has said first

access right or not, based on said first access right information received from said electronic medical record showing means through said second communication unit (Ross: Fig. 2, item 101; col 6, section 101 "Security Validation Module").

D. As per claim 16, Ross discloses an electronic medical record information management system in accordance with claim 2, wherein:

said electronic medical record includes original data before new data are added (Ross: col 7, lns 18 – 31. The Examiner considers the existence of an "Historical medical record" to indicate the presence of original data prior to the addition of data from "new visits".).

E. As per claims 22, 25, and 26 they are method claims which repeat the same limitations of claims 2 and 16, the corresponding system claims, as a series of process steps as opposed to a collection of elements and are thus rejected for the same reasons as the system claims.

F. As per claim 30, it is rejected as per the adding means step of claim 2 above.

Claim Rejections - 35 USC § 103

Art Unit: 3600

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 18, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross as applied to claim 2 above, and further in view of Wallace et al (US Pat# 6,564,121, hereinafter Wallace).

A. As per claims 18 and 29, Ross fails to explicitly disclose an electronic medical record information management system in accordance with claim 2, wherein:

when data are transmitted between said electronic medical record information managing means and said electronic medical record showing means,

said data are encrypted and said encrypted data are transmitted, and when data are received at said electronic medical record information managing means and said electronic medical record showing means, said data are decrypted.

However, these features are well in the art as evidenced by the teachings of Wallace.

Wallace teaches dispensing medical products over a networked communications system (Wallace: Abstract), with patient medical data that is encrypted locally and decrypted at a remote location (Wallace: col 16, lns 22-32; Fig. 9B, items 522 and 508).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the use of data encryption/decryption taught by Wallace into the system of Ross with the motivation of better preserving the confidentiality of patient information as it is transmitted over a network (Wallace: col 2, lns 30-35).

B. As per claim 28 it is a method claim which repeats the same limitations of claim 18, the corresponding system claim, as a series of process steps as opposed to a collection of elements. Since the collective teachings of Ross and Wallace disclose the structural elements that constitute the system of claim 18, it is respectfully submitted

that they perform the underlying process steps, as well. As such, the limitations of claim 28 are rejected for the same reasons given above for claim 18.

The motivation for incorporating the features of Ross and Wallace is as given above in the rejection of claim 18, and is incorporated herein.

(10) Response to Argument

Appellant's arguments have been considered but are not found to be persuasive. Concerning the applied Ross reference, beginning on page 11 of the appeal brief, Appellant's essential argument is that Ross does not teach a certain feature, namely the following, as recited in exemplary claim 2:

"said control server judges whether a user who transmitted said request is a user who has a second access right or not, and when said user has said second access right, said control server makes said electronic medical record storer store said electronic medical records."

Above, in the grounds of rejection for this feature in claim 2, the Examiner has reproduced the grounds from the final rejection under appeal which cites the following:

Ross: Fig. 2, item 101; col 6, section 101 "Security Validation Module",
note the variety of methods described by which personnel can

demonstrate their identity. Note further the restrictions on types of information different types of personnel are allowed to store on the system, for example, physicians can write prescriptions, but clerks can only enter demographic information. In this example, the Examiner considers that the physician has a second access right with respect to the clerk.

To reiterate, the cited passage clearly describes several different levels of access rights - at least for physicians, nurses, ward clerks, and record clerks. Each type of right permits access to various system functionalities, for instance a physician may generate a prescription, but a record clerk may not. The Examiner considers this to demonstrate that the system of Ross has at least two levels of access rights, and that one category of user would be considered to have a second access right. So for example, record clerks may have a first access right, ward clerks a second access right, nurses and physicians a third and fourth, respectively, and so on.

In the first full paragraph on page 12, apparently as criticism of the applicability of the Ross reference, Appellant makes several assertions. First, Appellant states, "The validation procedures of Ross merely validate a user to access the entire system and provide rights to certain functions or areas of the system." The Examiner asserts that in fact, the "validation procedures" of Ross **do not** provide a user access to the entire

system, but rather clearly limit access of various classes of users to only **certain** functions or areas of the system as previously discussed.

Appellant goes on to categorically state that, "...in Ross, all users, once so validated, have automatic access to all patient records." Appellant provides no citation in the Ross reference for this assertion, and the Examiner has not been able to find such evidence either. For example, nowhere in Ross is it stated or implied that a physician has access to all patient records, regardless of whether or not the patient is a patient of that physician. Rather the reference states that only physicians can write prescriptions, and other staff may not. Indeed, Ross teaches in col 3, ln 65 to col 4, ln 4 the use of a "physician-specific list" of prescribed drugs to facilitate writing prescriptions, indicating each doctor has access to a unique list of drugs known to be often prescribed by that doctor. The Examiner feels it would be highly presumptive to assume that any user had equal access to such a list. The Examiner submits that at his point, the existence of the teaching by Ross of differential access rights has been well demonstrated.

Next, Appellant states that the control server of Ross does not make, "...a rights determination *after* a request for a patient record has been made." Appellant is apparently relying on the temporal relationship between 1) when a request is sent, and 2) when the determination is made as to whether or not the sender has an access right, to establish the uniqueness of this feature. In response, the Examiner notes that in the

system of Ross, if a nurse tries to write a prescription for a particular patient, the system determines that the nurse does not have proper access and rejects this request, since only a physician may write a prescription.

Finally, Appellant asserts that Ross fails to teach that based on a request for a medical record, the record is sent to the requestor. In response, the Examiner points for example to Ross: col 2, Ins 65-67 which teaches a record ("summary") being "called up at any time." Further in col 2, Ins 4-6, Ross teaches that physicians have "remote access" to medical records, and that records are "rapidly retrievable" (Ross: col 1, Ins 1-2).

On page 12, third full paragraph, Applicant states that Ross does not teach a "control server." In response, the Examiner first points to Ross, col 4, In 51 to col 5, In 10 which describes the network architecture of the system including a plurality of component servers. The Examiner next asserts that the "Security Validation Module" previously cited (Ross: col 6, Ins 50-64), due to the networked structure of the system, resides on a server, and by nature of its function, exerts a type of system control, i.e. control over user access, and is thus reasonably considered to be a type of "control server."

Beginning on page 14, Appellant argues essentially that combination of the references applied to claims 18, 28, and 29, i.e. Ross and Wallace, is improper -

particularly that there is no "reason or motivation" to combine them. In response, first the Examiner has reproduced the motivation to combine these references from the grounds of rejection for claims 18 and 29 above, which recites the following:

"It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the use of data encryption/decryption taught by Wallace into the system of Ross with the motivation of better preserving the confidentiality of patient information as it is transmitted over a network (Wallace: col 2, lns 30-35)."

The Examiner next notes that the 1) application under appeal, 2) the Ross reference as discussed above, and 3) the Wallace reference (Wallace: abstract), all share a similar field of endeavor, i.e. that of securely managing patient information and records. Thus an individual of ordinary skill in this field is presumed to have had access to the references at the time the invention. The Examiner further points out that the teachings of Wallace relied upon to combine with Ross pertain to the encryption of patient related data. As discussed above, Ross is clearly concerned with data security by virtue of the disclosed "Security Validation Module," though there is no specific teaching of data encryption. Wallace, as cited in the claim rejections above, provides this missing teaching, thus addressing the problem of patient data security, the same problem that is addressed by claims 18, 28, and 29. The Examiner thus maintains that the applied combination of references is properly motivated and teaches the recited

features of these claims. The Examiner further concludes that the references are analogous art with respect to each other, as well as to the application under appeal.

Appellant through implication attempts to show that the Ross and Wallace references address different problems with respect to one another. In other words, it is asserted that Ross and Wallace respectively teach centralized versus distributed overall systems – and are presumably therefore non-analogous art. The Examiner has addressed this issue above, and considers it resolved. Similarly, Appellant's conclusion that "Ross teaches away from using a distributed system," is presumably an attempt to assert that all of Ross is taught away from Wallace, which is not true. For the reasons previously discussed, the Examiner asserts that the features taught by Wallace and combined with Ross are completely proper. The preceding likewise holds true for Appellant's assertion that combination of Wallace with Ross would result in "decreased efficiency" of data storage and presumably would thus be improper. Wallace solves the problem of encryption, and the asserted concern with efficiency is not relevant.

Finally, Appellant's assertion that the system of Ross would have no need to encrypt or decrypt has no supported basis. Data encryption generally is a protection against unauthorized access or acquisition of data on a computer network. Ross does not teach this feature which is claimed by Appellant, but as discussed above, Wallace does, and the addition of this teaching to the invention of Ross would provide for more secure transfer of patient data.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Martin A. Gottschalk/

Examiner, Art Unit 3696

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Art Unit 3696